

REMARKS

Claims 18-26, 28-36, and 40-48 are pending and claims 1-17, 27, and 37-39 have been canceled in a previous response. No amendments are made by this Response.

I. Rejection under 35 U.S.C. § 103

Based on a new ground of rejection, the Office rejects claims 18-26, 28-32, 35, 36, and 40-48 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,721,026 to Feder et al. ("Feder") in view of U.S. Patent No. 6,024,946 to Dubief et al. ("Dubief") and EP 0-240-349 to Bolich ("Bolich"). Office Action at page 2. Applicants respectfully disagree and traverse the rejection for the following reasons.

According to the Office, Feder teaches the aqueous dispersion comprising at least one insoluble polymer, an emulsion comprising at least one non-aminated silicone α,ω -disilanol, and a cosmetically acceptable medium. *Id.* at page 3. The Office, however, admits that "Feder et al. does not teach propellants . . . or a percent weight of the silicone." *Id.* Without these teachings, the Office must rely on the teachings of Dubief to supply a weight percent of the silicone and Bolich to supply a propellant and weight percent thereof. *Id.* at pages 4-5. Despite the Dubief and Bolich teachings, this new ground of rejection does not provide any motivation or suggestion as to the desirability of modifying the composition of Feder to include the recited amount of the at least one non-aminated silicone α,ω -disilanol, the propellant, and the weight of the propellant, as in the previous rejections.

As explained by the Federal Circuit, “an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). As such, the Federal Circuit requires that “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *Id.*, 47 U.S.P.Q.2d at 1458. This requisite motivation safeguards against hindsight and rote application of the legal test for obviousness. *Id.*

In this case, the Office states that it would be obvious to incorporate the percent weight teachings of Dubief because “Dubief et al. teaches ranges of silicone and polymer particle weight percentages that *either encompass or overlap with the percentages of the claims of the instant invention.*” *Id.* at page 8 (emphasis added). The Office is clearly basing its motivation on improper hindsight reasoning. A similar rationale is also relied upon by the Office to provide the alleged motivation to combine these teachings with those of Bolich. *Id.* at pages 5 and 6. As such, the Office again fails to provide the necessary motivation for this combination of references.

Furthermore, the Office continues to take the position that the disclosure in Feder at Col. 11, ll. 6-19 directed to cosmetic compositions provides “specific” motivation for the use of such compositions in both hair and facial cosmetics. *Id.* at page 9. The dozen or so lines of disclosure the Office relies on as providing “specific” motivation hardly amount to the “clear and particular” evidence required to provide the requisite

suggestion or motivation to modify the cited reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

Instead, Feder only generally provides that “the dispersions according to the invention *can* also be employed in cosmetology” Feder at Col. 11, ll. 6-8 (emphasis added). Cosmetic compositions are generally known to take on many forms; none of which are even alluded to in Feder.

Moreover, from Col. 2, line 65-Col. 11, line 5, Feder discloses aqueous silicone dispersions “for the production of elastomeric silicone seals in the construction industry,” which amounts to at least 5 pages of disclosure. *See also* Feder at Abstract. It is only at the tail end of that disclosure, i.e., from Col. 11, ll. 9-19, that Feder provides even a general statement regarding cosmetic compositions. With this general disclosure, Feder provides no guidelines, no selection criteria, and/or no teachings to suggest the specific combination useful in the cosmetic arts. Feder’s general disclosure of cosmetic compositions and failure to identify a particular dispersion does not meet the requirements under Section 103 sufficient to establish a prima facie case of obviousness. *See Dembiczak*, 175 F.3d at 999. 50 U.S.P.Q.2d at 1617.

Instead, the Office relies on the general disclosure of cosmetic compositions, i.e., permanent waving that creates a porous elastomeric film on the strands of hair, as the alleged evidence of a motivation to combine particular cosmetic ingredients found in Dubief and Bolich. The short passage identified by the Office in Feder, however, contains no guidelines as to obtaining the particular form of the claimed invention or how to achieve it. *See, e.g., In re O’Farrell*, 853 F.2d 894, 7 U.S.P.Q.2d 1673 (Fed. Cir.

1988). As such, the Office's rationale is based on an "obvious to try" standard, which is not the standard under Section 103.

This "obvious to try" rationale asserted by the Office is again seen in the Office's response to Applicants' argument regarding the teachings of Example 1 and Table 1 of Feder. Office Action at pages 10-11. The Office asserts that because the mechanical properties are not shown as being undesirable in hair cosmetics and are allegedly consistent with the specific motivation provided by Feder for preparing a hair cosmetic, there exists a suggestion in Feder to incorporate specific cosmetic ingredients drawn to aerosol mousse compositions and compositions for treating keratinous materials. *Id.* Example 1 and Table 1 are directed to the adhesiveness of Feder's composition on glass and concrete that supports Feder's broad disclosure of an aqueous silicone dispersion "for the production of elastomeric silicone seals in the *construction industry*." Feder at Abstract (emphasis added). Neither the Office nor Feder makes the assertion that the glass and concrete substrates in Example 1 and Table 1 are equivalents or analogous to keratinous material or skin for cosmetic use.

Furthermore, "in order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992); *see also*, *In re Clay*, 966 F.2d 656, 659, 23 U.S.P.Q.2d 1058, 160-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering

his problem.”). In this case, the Office provides no evidence to suggest that Feder is “reasonably pertinent” to the problem identified in the presently claimed invention. As such, the dozen or so lines directed to cosmetic compositions amount to nothing more than an invitation to experiment, not to the “clear and particular” evidence required to provide a suggestion or motivation to combine that thwarts a hindsight based rationale. Thus, a prima facie case of obviousness has not been satisfied and as such, Applicants respectfully request the withdrawal of the rejection.

II. Double Patenting

The Office also rejects claims 18-26, 28-32, 35, 36, and 40-48 under the judicially created doctrine of obviousness-type double patenting over claims 1-8 and 35-44 of U.S. Patent No. 6,165,446 (“the ‘446 patent”). Office Action at page 7. Applicants respectfully disagree and traverse the rejection for the following reasons.

Under an obviousness-type double patenting rejection, this rejection is analogous to the nonobviousness requirement of 35 U.S.C. § 103 except that the patent principally underlying the double patenting rejection is not considered prior art. M.P.E.P. § 804 IIB(1), III (8th ed. Rev. 2, 2004). As such, the requirements under obviousness-type double patenting parallel the analysis for a 35 U.S.C. § 103 obviousness determination. *Id.* When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art and only the claims of the application in view of the issued patents are to be compared. *Id.* The specification can only be used as a dictionary to learn the meaning of a term in the patent claims. *In re Boylan*, 392 F.2d 1017, 157 U.S.P.Q. 370 (C.C.P.A. 1970).

The present application recites in the claims, among other things, an emulsion comprising at least one *non-aminated* silicone α,ω -disilanol” See independent claim 18 (emphasis added). Unlike the present application, the ‘446 patent recites, among other things, “at least one silicone” See independent claims 1 and 35. Looking to the ‘446 specification to determine the meaning of the term “at least one silicone,” the ‘446 patent does not require the silicone to be “non-aminated” and in fact, teaches that silicones can be optionally substituted with other types of radicals capable of being bonded either directly or via a hydrocarbon radical to the siloxane chain. The ‘446 patent at Col. 4, ll. 21-46. The ‘446 patentees indicate that “other” types of radicals may include, for example, substituted or unsubstituted amino groups, amide groups, and quaternary ammonium groups. *Id.* at Col. 4, ll. 41-44. This is in direct contrast to the teachings and recitation in the claims of the present application that “according to the invention, non-aminated silicone α,ω -disilanol denotes any silicone not comprising at least one primary, secondary or tertiary amine or one quaternary ammonium group.” Application at page 12, ll. 10-13.

“A prior art reference that ‘teaches away’ from the claimed invention is a significant factor to be considered in determining obviousness” M.P.E.P. § 2145(X) (8th ed. Rev. 1, 2004). Thus, the ‘446 patent’s teaching of the use of aminated silicone, i.e., substituted or unsubstituted amino groups, amide groups, and quaternary ammonium groups bonded to the silicone backbone, teaches away from the presently claimed invention. Moreover, the Office fails to point to anything in the ‘446 specification for the selection of “non-aminated” silicones motivating a skilled artisan.

As such, the Office fails to establish an obviousness-type double patenting rejection.

Accordingly, Applicants respectfully request the withdrawal of the rejection.

III. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

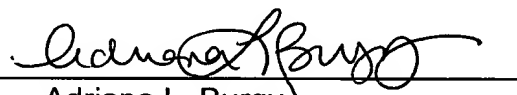
If the Examiner believes that a telephone conference call could be useful in resolving any outstanding issues, he is respectfully urged to contact Applicants' undersigned counsel at 202.408.4345.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 17, 2005

By: 
Adriana L. Burgy
Reg. No. 48,564